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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

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Technology Center 2100

Application Number: 09/690,002
Filing Date: October 16, 2000
Appellant(s): HARRIS, SCOTT C.

Scott C. Harris
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5 January 2007 appealing from the Office action mailed 9 February 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The Final Rejection (dated 9 February 2006) contained an inadvertent typo. The Final Rejection included the rejections of claims 15 and 16 under 35 U.S.C. 103(a) over AAPA in view of Horvitz, however Examiner inadvertently left out claims 15 and 16 in the preamble of the rejection. The changes are as follows:

Claims 1-7, 14-16, 23, 24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Horvitz et al. (U.S.

6,161,130).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,493,007	Pang	12-2002
6,161,130	Horvitz et al.	12-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

1.   Claims 14-16 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Computer programs claimed as computer

listings per se, i.e., the descriptions or expressions of the programs are not physical

"things". They are neither computer components nor statutory processes, as they are

not "acts" being performed. Such claimed computer programs do not define any

structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Claims 14-16 include an email program comprising: a display and a plurality of controls. Such limitations are simply features of the email program. In other words, the program includes <u>code to display</u> the emails; the program includes <u>code to provide controls</u>. There is no physical structure defined or any functional interrelationships between the email program and any actual physical elements of a computer.

On page 3 of Applicant's Specification, Applicant provides evidence that Applicant intends the email program to include an email browser window as a display, the browser window 100 including a number of operating buttons 102 (page 3, lines 14-16, Fig. 1, 100). This browser window and the buttons are clearly software that make up the computer program that is claimed.

M.P.E.P. 2601.1 Section I states, "Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material."

Claims 14-16 do not provide the computer-readable medium needed to realize the email program's functionality. As such, claims 14-16 are not limited to statutory subject matter and are therefore non-statutory.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Pang (U.S. 6,493,007).

1.   Regarding clam 14, Pang disclosed an e-mail program having instructions embodying on a computer readable media that are executable by a computer, comprising:

a display portion which displays a plurality of e-mails (Figure 4),

a plurality of controls including at least a first control which selects deleting an e-mail while indicating that said e-mail is spam (Fig. 5, Button 521 labeled "NO SPAM!", col. 8, lines 13-18, Pang disclosed that the "NO SPAM!" Button removes the e-mail message or disposes the email message into the trash, which clearly shows that the

email message is spam and the user wants to delete it), and a second control which

selects deleting an e-mail while indicating that said e-mail is not spam (col. 8, lines 12-

13, Figure 5, Button 519 labeled "Delete" for deleting email, col. 8 line 63-column 9 line

13, column 10 lines, lines 30-36, Pang disclosed "the user can delete the desired e-mail

messages". Clearly this "Delete" button, when used, indicates to the system that the

email message is not spam but should be deleted. Otherwise there is no point for the

"NO SPAM!" button which is used to clearly indicate that the email is spam and the user

doesn't want to receive similar email).

Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Horvitz et al.

(U.S. 6,161,130).

2.   Regarding clam 14, Horvitz disclosed an e-mail program having instructions

embodying on a computer readable media that are executable by a computer,

comprising:

        a display portion which displays a plurality of e-mails (Horvitz, Fig. 2, 220 "INBOX

folder" clearly used for displaying emails),

        a plurality of controls including at least:

        a first control which selects deleting an e-mail while indicating that said e-mail is

spam (Horvitz, Fig. 2, 223 and 227, Horvitz disclosed a system that analyzes messages

and categorizes them according to user specified rules, as to whether the message is

spam or it is legitimate; col. 8, lines 64-66, Horvitz disclosed the system having a

control that can delete spam outright, i.e. without user intervention, meaning there is a

clear indication that the email is spam, and there is a control that automatically deletes

this spam), and

a second control which selects deleting an e-mail while indicating that said e-mail

is not spam (Horvitz, Fig. 2, 223 shows a legitimate mail folder, which stores email

messages that are not spam, and therefore indicates that the email messages are not

spam. col. 6, lines 55-60, Horvitz disclosed the email program being utilized with any

email program. Applicant states that standard email programs provide a conventional

delete button (Applicant's Specification, page 4, lines 15-17, line). Since the teachings

of Horvits can be utilized with any email programs, it is inherent that the user is provided

with a conventional delete button to delete email from this legitimate folder. Since the

email is in the legitimate folder, this provides an indication that it is not spam.

Therefore, deleting message from this folder, using the conventional delete button,

deletes the messages while indicating that it is not spam. Therefore Horvitz provides a

control to delete the email message while indicating that it is not spam).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7, 14, 23, 24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Pang (U.S.

6,493,007).

3.   Regarding claims 1, 14, and 23, AAPA discloses the existence of web email

programs in which electronic mail messages are received (AAPA, page 1, Background,

lines 7-16). AAPA also discloses a conventional "delete message" button used to

delete email messages without indicating whether it is spam or not (AAPA, page 4, line

15 through page 16, line 5, FIG. 1, 107).

AAPA also discloses that email may be filtered for spam (AAPA, page 1,

Background, lines 15-20, AAPA discloses that junk email from a specified sender may

be blocked, automatically deleted or sent to the trash).

AAPA does not explicitly state displaying information about the electronic mail

message in a way that allows deleting a message while indicating that it is spam, and

deleting the message while indicating that it is not spam.

In an analogous art, Pang disclosed a method and device for removing junk

email that provides a button called "NO SPAM!" that deletes the e-mail message and

clearly shows that the email message is spam and the user wants to delete it and never

receive that type of email again by removing the user from whatever list he is on (col. 8,

lines 13-18, Horvitz clearly shows this button used to remove email while indicating it is

spam). Pang also disclosed a "Delete" button 519 in which "the user can delete the

desired e-mail messages". Clearly this "Delete" button, when used, indicates to the

system that the email message is not spam but should be deleted. Otherwise there is

no point for the "NO SPAM!" button which is used to clearly indicate that the email is

spam and the user doesn't want to receive similar email (col. 8, lines 12-13, Figure 5,

Button 519 labeled "Delete" for deleting email, col. 8 line 63-column 9 line 13, column

10 lines, lines 30-36).

Pang disclosed that the system may be utilized with any standard typical email

client applications (Pang, col. 5, lines 50-55). This would have motivated one of

ordinary skill in the art to combine the conventional teachings of a standard email

system, as explained in AAPA, with the email system of Pang.

Therefore it would have been obvious to one of ordinary skill in the art at the time

the invention was made to incorporate the teachings of providing the ability to remove

emails whether they are spam or desired for the benefit of allowing users to manage

their mailbox without the automatic deletion, possibly leading to filtering out legitimate

bulk email messages that are of interest to the user (Pang, col. 2, line 64 through col. 3,

line 5) providing user's with more efficient management tools for managing their email.

4.   Regarding claims 2-3, and 24, AAPA and Pang disclosed the limitations,

substantially as claimed, as described in claim 1, including storing a database of spam

likelihood, and wherein said deleting while indicating updates information in the

database (Pang, co. 6 lines 27-39) and while indicating update rules in a rules database

(Pang, col. 6 lines 27-39).

5.   Regarding claims 4-5, AAPA and Pang disclosed the limitations, substantially as

claimed, as described in claim 3, including wherein said rules include information about

fields from said electronic mail message (Pang, col. 6 lines 27-39) and wherein said

fields include at least a sender of the e-mail message, text, of the e-mail message, and

a subject of the e-mail message (Pang, col. 6 lines 27-39),

6.   Regarding claim 6, AAPA and Pang disclosed the limitations, substantially as

claimed, as described in claim 5, including wherein said fields also include a domain of

a sender of the e-mail message (Pang, col. 6 lines 27-39).

7.   Regarding claim 7, AAPA and Pang disclosed the limitations, substantially as

claimed, as described in claim 3. AAPA and Pang did not explicitly state that an email

includes links. Examiner takes Official Notice (see MPEP § 2144.03) that email

messages containing links in an email program environment was well known in the art

at the time the invention was made. The Applicant is entitled to traverse any/all official

notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses

such an assertion, the examiner should cite a reference in support of his or her

position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724,

169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain

adequate information or argument to create on its face a reasonable doubt regarding

the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ

231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to

challenge either the correctness of the fact asserted or the notoriety or repute of the

reference cited in support of the assertion. We did not mean to imply by this statement

that a bald challenge, with nothing more, would be all that was needed". Further note

that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a

traversal by the Applicant that is merely "a bald challenge, with nothing more" will be

given very little weight. See the following references for the use of links within email

addresses: a) Bergh et al. (U.S. 2002/0026356), paragraph 75. b) Huang et al. (U.S.

2003/0097361), paragraph 79. c) Shaak et al. (U.S. 2002/0198784), paragraph 50

Claims 1-7, 14-16, 23, 24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Horvitz et al. (U.S.

6,161,130).

8.   Regarding claims 1, 14, 16, and 23, AAPA discloses the existence of web email

programs in which electronic mail messages are received (AAPA, page 1, Background,

lines 7-16). AAPA also discloses a conventional "delete message" button used to

delete email messages without indicating whether it is spam or not (AAPA, page 4, line

15 through page 16, line 5, FIG. 1, 107).

AAPA also discloses that email may be filtered for spam (AAPA, page 1,

Background, lines 15-20, AAPA discloses that junk email from a specified sender may

be blocked, automatically deleted or sent to the trash).

AAPA does not explicitly state displaying information about the electronic mail message in a way that allows deleting a message while indicating that it is spam, and deleting the message while indicating that it is not spam.

In an analogous art, Horvitz disclosed a technique which can be utilized in substantially any email or electronic messaging application to detect messages which a given user is likely to consider "junk", in which the technique utilizes a probabilistic classifier to detect "junk" email, and provide separate folders for **legitimate** mail (Horvitz, Fig. 2, 223) and **spam** email (Horvitz, Fig. 2, 227). Horvits also disclosed an intermediate folder for email messages that may or may not be spam (col. 8, lines 62-65). Horvitz also allows users to update rules that the classifier follows in order to automatically determine the type of email, the updating of rules being based on how users manage their email (Horvitz, col. 5, lines 52-65).

The teachings of Horvitz also allow messages to be classified into categories including "certain-spam" (as in definitely spam), "questionable spam", and "non-spam". (Horvitz, col. 5, lines 15-21). Therefore, Horvitz includes the concept of being able to **indicate** the type of email a message is, whether **spam** or **legitimate**.

Since the technique of Horvitz works with standard email programs, it would have been obvious to one of ordinary skill that the technique of Horvitz includes the ability to delete email from each folder, as standard email programs include a "delete" button to delete emails. Therefore, when a user deletes a message from the "legitimate" folder, the message is being deleted with an indication that it is not spam. When a user deletes a message from the "spam" folder the message is being deleted with an

indication that it is spam. When the user deletes a message from the inbox of the

standard email program, the message is being deleted without an indication that it is

spam or not.

Since the technique of Horvitz can be utilized in any other email applications

(Horvitz, col. 6, lines 55-60), it would have been obvious to one of ordinary skill in the art

at the time the invention was made to incorporate the technique of Horvitz into

conventional email programs as specified by AAPA for the benefit of allowing the users

to individually filter their incoming messages, by their content, as they saw fit based on

user preferences of the content (Horvitz, col. 4, lines 31-37), providing user's with more

efficient management tools for managing their email.

9.   Regarding claims 2-3, 24, AAPA and Horvitz disclosed the limitations,

substantially as claimed, as described in claim 1, including storing a database of spam

likelihood, and wherein said deleting while indicating updates information in the

database and while indicating update rules in a rules database (Horvitz, col. 5, lines 50-

65, col. 8, lines 55-67).

10.   Regarding claims 4-5, AAPA and Horvitz disclosed the limitations, substantially

as claimed, as described in claim 3, including wherein said rules include information

about fields from said electronic mail message and wherein said fields include at least a ·

sender of the e-mail message, text, of the e-mail message, and a subject of the e-mail

message (Horvitz, col. 9, lines 15-50, col. 10, lines 10-25),

11.   Regarding claim 6, AAPA and Horvitz disclosed the limitations, substantially as

claimed, as described in claim 5, including wherein said fields also include a domain of

a sender of the e-mail message (Horvitz, col. 9, lines 25-35).

12.   Regarding claim 7, AAPA and Horvitz disclosed the limitations, substantially as

claimed, as described in claim 3. AAPA and Horvitz did not explicitly state that an email

includes links. Examiner takes Official Notice (see MPEP § 2144.03) that email

messages containing links in an email program environment was well known in the art

at the time the invention was made. See the previous Official Notice Rejection of claim

7 for further detail.

13.   Regarding claim 15, AAPA and Horvitz disclosed the limitations, substantially as

claimed, as described in claim 14. AAPA and Horvitz also disclosed allowing the user

to be able to visually distinguish the message based on the color of the message, the

color of the message deemed to be a certain degree of spam (Horvitz, col. 5, lines 20-

30). AAPA and Horvitz did not explicitly state displaying a likelihood of spam coefficient

which indicates, on a weighted scale, a likelihood that the associated message

represents spam. However, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to display a coefficient rather than distinguish by

color since both functionalities produce the same outcome, which benefits users by

providing them a way to determine to what degree the message is considered spam.

(10) Response to Argument

Rejections under 101

Applicant argues that the rejections for claims 14-16 under 101 are improper.

Examiner respectfully disagrees.

Claim 14 recites, "An email program comprising." Clearly the intent of this group

of claims is to claim only a program. The U.S. Patent Office does not grant patents to

claims that contain only computer programs (i.e. software).

M.P.E.P. 2601.1 Section I, states, "Since a computer program is merely a set of

instructions capable of being executed by a computer, the computer program itself is

not a process and USPTO personnel should treat a claim for a computer program,

without the computer-readable medium needed to realize the computer program's

functionality, as nonstatutory functional descriptive material."

Argument #1

Applicant argues, "Since there is a display and controls, the combination MUST

represent a physical thing. The sequence of events clearly interacts with the real world.

A display is a real thing-it cannot in any sense be thought of as 'nonstatutory.'" [see

Appeal Brief, page 4, paragraph 2].

Examiner respectfully disagrees.

On page 3 of Applicant's Specification, Applicant provides evidence that
Applicant intends the email program to include an email browser window as a display,
the browser window 100 including a number of operating buttons 102 (page 3, lines 14-
16, Fig. 1, 100). This browser window and the buttons are clearly software that makes
up the computer program that is claimed.

Claims 14-16 include an email program comprising: a display and a plurality of
controls. Such limitations are simply features of the email program. In other words, the
program includes <u>code to display</u> the emails; the program includes <u>code to provide</u>
<u>controls</u>. There is no physical structure defined or any functional interrelationships
between the email program and any actual physical elements of a computer.

As explained above, M.P.E.P. 2601.1 Section I states, "Since a computer
program is merely a set of instructions capable of being executed by a computer, the
computer program itself is not a process and USPTO personnel should treat a claim for
a computer program, without the computer-readable medium needed to realize the
computer program's functionality, as nonstatutory functional descriptive material."

Claims 14-16 do not provide the computer-readable medium needed to realize
the email program's functionality. As such, claims 14-16 are not limited to statutory
subject matter and are therefore non-statutory.

Argument #2

Applicant asserts, "Claim 14 also controls deleting emails, and as such, changes something from one state to another. As such, this represents a statutory claim under 35 USC 101."

Examiner respectfully disagrees.

Claim 14 does not provide any "sequence of events" but rather just lists software components of the email program. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs are not physical "things". They are neither computer components nor statutory processes, as they are not "acts" being performed, and therefore the claim is not a process. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. As such, claims 14-16 are not limited to statutory subject matter and are therefore non-statutory.

Art Rejections

Before a detailed response to Applicant's arguments with the prior art, Examiner would like to point out some major key factors in interpreting the present claims.

Independent claims 1, 14, and 23 all include language similar to, "indicating that a message is spam", "indicating that a message is not spam", and "without indicating whether the message is spam or not."

KEY FACTORS

1.   The claims do not disclose who or what is doing the indicating.

2.   The claims do not disclose who or what is being indicated.

3.   The claims do not disclose how these indications are used.

In view of the above key factors, these "indicating/without indicating" limitations in

their broadest reasonable interpretation may be interpreted by the Examiner to be

performed using one delete button. A single delete button would have obviously

satisfied the functionality for all of the three claimed buttons/controls/steps, with the

reason being that a person can indicate to, for example, a friend sitting next to him/her,

that an email is spam, and then press the delete button to delete it. A person can

indicate to a friend sitting next to him/her, that an email is not spam and then press the

delete button to delete it. A person could also just hit the delete button without any

indication whatsoever.

MPEP § 2111 states:

"While the claims of issued patents are interpreted in light of the specification,

prosecution history, prior art and other claims, this is not the mode of claim

interpretation to be applied during examination. During examination, the claims must be

interpreted as broadly as their terms reasonably allow." See also *In re American*

Academy of Science Tech Center, 2004 WL 1067528 (Fed. Cir. May 13, 2004).

Further, although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)*.

Therefore, it is the Examiner's opinion that the "indicating/without indicating" limitations of the claims, in their broadest reasonable interpretation would be satisfied as explained above. As shown previously and as will be explained below, the rejections that have been made both anticipate and render obvious these key factors of the claimed invention.

Rejections under 102

Claim 14 Rejected under 35 USC 102(b) over Pang

Applicant argues, "There is no deletion control in Pang that indicates that the email is not spam [see Appeal Brief, page 6, 3rd paragraph]. Applicant also argues, "The delete button certainly does not indicate that the item being deleted within Pang that it is, or is not, spam. Both spam and non-spam can be deleted with the delete button" [see Appeal Brief, page 7, 1st paragraph].

Examiner respectfully disagrees.

Pang disclosed a "Delete" button (see Figure 5, Button 519, col. 8, lines 12-13) for deleting email. To explain why this "Delete" button, when used, indicates that the email is not spam, Examiner notes that Pang also disclosed a "NO SPAM!" button (see Figure 5, Button 521), which is used to clearly indicate that the email is spam and the

user doesn't want to receive similar email (Pang , col. 8, lines 13-18). Therefore, if a

user clicks this "NO SPAM!" button, the system receives <u>indication</u> that the selected

email <u>is SPAM</u> and the user wants to delete it and also not receive anymore email from

the sender.

With that being said, the user needs a way to delete an email message where

the system does not treat the message as it does for spam. The "Delete" button 519

provides this functionality. Pang disclosed, "The user opens <u>desired e-mail messages</u>

(step 609) and removes them based upon the title or subject line, for example" (see

Pang, col. 9, lines 4-5). When the user uses the "Delete" button 519, the control

indicates to the system that the email message is not to be treated as spam (Otherwise

the user would have used the "NOSPAM!" button). An indication is clearly provided that

the email is not spam since the system does not treat it as spam.

<u>Claim 14 Rejected under 35 USC 102(b) over Horvitz</u>

Applicant argues, "Horvitz does not teach a control as indicated by the rejection, but

rather teaches a mail classifier, that classifies mail as being legitimate mail, or spam

mail. There is no teaching or suggestion of a control that controls, as claimed, delete as

not spam" [see Appeal Brief, page 7, last paragraph].

Examiner respectfully disagrees.

Horvitz disclosed a legitimate mail folder (Fig. 2, 223), which stores email

messages that are not spam, and therefore indicates that the email messages in this

folder are not spam. Horvitz disclosed the email program being utilized with any email

program (col. 6, lines 55-60). Applicant states that standard email programs provide a conventional delete button (Applicant's Specification, page 3, lines 14-17, page 4, lines 15-17). Since the teachings of Horvitz can be utilized with any email programs, it is inherent that the user is provided with a conventional delete button to delete email from this legitimate folder. Since the email is in the legitimate folder, this provides an indication that it is not spam. Therefore, deleting messages from this folder, using the conventional delete button, deletes the messages while indicating that it is not spam. Therefore Horvitz provides a control to delete the email message while indicating that it is not spam.

Rejections under 103

Claims 1-7, 14, 23, 24 Rejected under 35 USC 103 over Applicant's Admitted Prior Art (AAPA) in view of Pang.

Applicant reasserts the same arguments provided above for 102 over Pang [see Appeal brief, page 8, second paragraph].

Examiner respectfully disagrees for the same reasons provided in the response to Applicants arguments for the 102 rejection under Pang.

<u>Claims 1-7, 14, 15, 23, 24 Rejected under 35 USC 103 over Applicant's Admitted Prior</u>

<u>Art (AAPA) in view of Horvitz.</u>

Applicant asserts, "The argument apparently attempts to contend that since standard e-mail programs include a delete button, that these delete buttons must be able to choose spam or not spam. Quite simply, this is hindsight, since what it was never taught or suggested by Horvitz. It attempts work backwards from what is taught by the present application." [see Appeal Brief, paragraph 3].

Examiner respectfully disagrees.

As explained above, Horvitz disclosed a legitimate mail folder (Fig. 2, 223), which stores email messages that are not spam, and therefore indicates that the email messages in this folder are not spam. Horvitz disclosed the email program being utilized with any email program (col. 6, lines 55-60). Applicant states that standard email programs provide a conventional delete button (Applicant's Specification, page 3, lines 14-17, page 4, lines 15-17). Since the teachings of Horvitz can be utilized with any email programs, it is inherent that the user is provided with a conventional delete button to delete email from this legitimate folder. Since the email is in the legitimate folder, this provides an indication that it is not spam. Therefore, deleting messages from this folder, using the conventional delete button, deletes the messages while indicating that it is not spam. Therefore Horvitz provides a control to delete the email message while indicating that it is not spam.

In simple terms, Horvitz provides an email system with two folders, legitimate and spam. It was within the knowledge of one of ordinary skill in the art that users can delete email from each of these folders, since in fact it is an email program. The whole purpose of an email program is to manage email, which includes deletion. Applicant clearly shows this in Applicant's admitted prior art. Therefore, when a user deletes a message from the legitimate folder, the message is deleted while indicating that it is not spam.

This is clearly not hindsight as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure. Therefore, such a reconstruction is proper." In re McLaughlin 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

Applicant asserts, "The rejection attempts to contend that somehow the delete function from standard e-mail programs could be applied to the different folders of Horvitz in exactly the claimed way. This is nothing but speculation.

Examiner respectfully disagrees.

The "claimed way", in its broadest reasonable interpretation, can mean deleting while indicating (or deleting without indicating) by the person deleting the message. Horvitz disclosed the email folders provided to the user in a client email application (Horvitz, col. 5, lines 5-10). It is within the knowledge of one of ordinary skill in the art that client email applications provide a delete button to delete email. Since Horvitz can

be utilized with standard email programs, Horvitz clearly taught the use of a delete

button. It was within the knowledge of one of ordinary skill in the art that one delete

button can be used to delete messages from multiple folders. The folder provides the

indication of the type of email. Horvitz clearly disclosed a Legitimate folder (Fig. 2, 223),

a Spam Folder (Figure 2, 227). Horvits also disclosed an intermediate folder for email

messages that may or may not be spam (col. 8, lines 62-65). Therefore, when the

messages are deleted using the delete button, there is a clear indication of whether they

are spam, not spam, or unsure if they are spam or not.

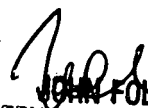## (11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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